

Serial No. 09/681,804
Art Unit: 2131

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 29-57 were pending in the application, of which Claims 29, 36, 44 and 52 are independent. In the Final Office Action dated November 17, 2005, Claims 29-35 and 52-57 are rejected under 35 U.S.C. § 112, first paragraph, and Claims 29-57 are rejected under 35 U.S.C. § 103(a). Applicant respectfully requests that the amendments be entered because they do not raise new issues. Indeed, the independent claims were amended to incorporate the limitations of dependent claims and to clarify the claimed subject matter. Alternatively, Applicant submits that the amendments reduce the issues for appeal.

1. Change to Attorney Docket Number

Please note that the Attorney Docket Number for this application is now **60197.0001USU01**. Applicant respectfully requests that future correspondence contain the new Attorney Docket Number.

2. Status of the Claims

Claims 29, 36, 41, 44, and 52 are amended. Claim 33 is canceled without prejudice or disclaimer.

Basis for the amendments to claims 29, 36, and 52 is found for example on page 15, lines 15-26.

Serial No. 09/681,804
Art Unit: 2131

Basis for the amendments to claim 44 is found for example on page 15, lines 15-26; page 4, lines 11-15; and page 12, lines 23-24; and page 14, lines 4-8.

3. Response To Rejection of Claims 29-35 and 52-57 Under 35 U.S.C. § 112, first paragraph

Claims 29-35 and 52-57 are rejected as allegedly failing to comply with the written description requirement. Claims 29 and 52 are independent. Applicant respectfully traverses the rejection and requests reconsideration in view of the following amendments and remarks.

Claim 29 as amended is generally directed to a method for authorizing execution of an object on a computer system by selecting an executable object on the computer system; inserting a first identifier into a steganographic zone of the object, wherein the first identifier and the stenographic zone of the object are formed by the computer system and the first identifier prevents execution of the executable object; and comparing the first identifier in the steganographic zone to a second identifier each time the object is selected for execution, wherein an executable version of the object is created if the first identifier matches the second identifier by extracting the first identifier from the executable object.

Claim 52 as amend is directed to a method for creation of authorized objects of a computer system comprising selecting an executable object for authorization, retrieving a system identifier from a storage device, embedding the selected object with the system identifier wherein the system identifier prevents execution of the object, storing data for retrieving the system identifier from the object on the storage device and

Serial No. 09/681,804
Art Unit: 2131

generating an executable copy of the object each time the object is selected for execution by extracting the system identifier from the object if the first identifier matches the second identifier.

Claims 29 and 52 and their dependent claims are rejected as allegedly lacking written support for "and the first identifier prevents the execution of the executable object" as well as "an executable version of the object is created if the first identifier matches the second identifier." Page 5, line 23 of the specification discloses that a computer's executables and non-executables are defined as DNA Objects. A DNA Scope Set is defined as the set of DNA Objects, i.e., executable and non-executables, having the same DNA Pattern (p. 5, lines 23-25). The DNA Pattern is defined as a collection of DNA Object properties that distinguish one Scope Set from another. A DNA Pattern is created for example, using a concatenation of the CPU number (see page 8, lines 6-17). The DNA Pattern is then inserted into the steganographic zone to create a new version of the DNA Object (see page 8, line 19 to page 11, line 15). Page 14, lines 4-8 disclose that the executable object is moved off-line, and the new form of the object containing the DNA Pattern is stored in the system library. Page 4, lines 11-15, disclose that execution of objects is accomplished only through the DNA Authentication Phase. As part of the DNA Authentication Phase, the DNA Pattern is extracted from the executable, and the original object is recreated (p. 15, lines 15-21). Applicant submits one of skill in the art would recognize that the DNA Pattern is a "first identifier" and that inserting it into the executable would create a new form of the object which is not executable until it proceeds through the Authentication Phase and has the DNA Pattern extracted.

Serial No. 09/681,804
Art Unit: 2131

It is well known that claim terminology need not be supported *ipsis verbis* in the specification. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, at 1563, 19 USPQ2d 1111 (Fed. Cir. 1991); *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient"). Applicant respectfully submits that specification contains sufficient written description so that one of skill in the art would understand that the inventor was in possession of the claimed invention at the time of filing based on the specification as discussed above.

4. Response To Claim Rejections Under 35 U.S.C. § 103(a)

Claims 29-57 are rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses the rejection.

Claims 29, 31, 32, 52, and 54 are rejected as obvious over U.S. Patent No. 6,612,044 to Rabb et al. in view of U.S. Patent Publication No. 2001/0037450 to Metlitske. The Office Action acknowledges that Rabb et al. fails to teach or suggest wherein an executable version of the object is created if the first identifier matches the second identifier. Metlitske is cited as curing this deficiency. Applicant respectfully disagrees.

To establish a *prime facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Additionally, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim

Serial No. 09/681,804
Art Unit: 2131

limitations. Applicant respectfully traverses the rejection for at least the reason that the combination of the cited references fails to teach or suggest all the claim limitations.

Amended independent claims 29 and 52 recite that the executable object is created by extracting the first identifier or system identifier respectively. Basis for this amendment is found for example on page 15, lines 15-26. Applicant respectfully submits that both Rabb et al. and Metlitske fail to teach or suggest at least this element.

Metlitske teaches that programs can be created that can only be executed using the specific trusted module with the corresponding keys. Metlitske fails to teach or suggest recreating an executable object by extracting a first identifier or a system identifier from a non-executable object. Accordingly, Applicant respectfully submits that the combination of Rabb et al. with Metlitske et al. fails to teach or suggest each element of the claims 29, 52, or their dependent claims.

Claims 30, 33-35, 52-54, 56 and 57 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rabb et al. in view of Metlitski and further in view of U.S. Patent No. 6,788,800 to Carr et al. Applicant respectfully traverses the rejection for at least the reason that the combination of the cited references fails to teach or suggest all the claim limitations:

Claim 30 depends from claim 29 and is not obvious over the cited references for at least the reason that the combination of references fails to teach or suggest recreating an executable object by extracting a first identifier or a system identifier from a non-executable object. Carr teaches that a embedded data in a digital watermark can be scanned and decoded. Carr fails to teach or suggest that a first identifier or system identifier can be extracted from a non-executable object to create an executable object.

Serial No. 09/681,804
Art Unit: 2131

Thus, the combination of the cited references fails to teach or suggest each element of the claims.

Claim 33 is cancelled and the rejection is moot with regard to this claim.

Claims 34-35 also depend from claim 29. Applicant submits that dependent claims 34 and 35 are not obvious in view of the cited references for at least the reason that claim 29 is not obvious over the cited references.

Claim 52 is independent and recites that an executable copy of the object is created by extracting the system identifier from the object each time the object is selected for execution. As noted above, neither Rabb et al. nor Metlitski teach or suggest this element of the claim. Carr also fails to teach or suggest this element. Therefore, claim 52 and its dependent claims are not obvious over the cited references for at least the reason that the cited references fail to teach or suggest every element of the claims.

Claims 36-51 are rejected as obvious over Carr in view of U.S. Patent No. 5,919,257. Applicant respectfully traverses this rejection for at least the reason that the combination of references fails to teach or suggest each element of the claims.

Amended claim 36 is directed to a method for identifying unauthorized objects on a computer system comprising authorizing objects of the computer system by embedding a system identifier into the authorized objects, determining the presence of the system identifier in objects of the computer, wherein objects that are not embedded with the system identifier are unauthorized, isolating unauthorized objects from the computer system, and creating an executable version of authorized objects by

Serial No. 09/681,804
Art Unit: 2131

extracting the system identifier each time a request for execution of the authorized objects is received.

Applicant respectfully submits that the combination of the cited references fails to teach or suggest at least the element of creating an executable version of authorized objects by extracting the system identifier each time a request for execution of the authorized objects is received.

CONCLUSION

The Examiner is respectfully requested to enter this Amendment After Final, in that it raises no new issues but merely places the claims in a form clearly allowable over the prior art of record. For at least these reasons, Applicant asserts that the pending claims 29-32, and 34-57 are in condition for allowance. The claims have not been amended for reasons related to patentability, but are amended to expedite the allowance of this case. Applicant further asserts that this response addresses each and every point of the Office Action, and respectfully requests that the Examiner pass this application with claims 29-32 and 34-57 to allowance. Should the Examiner feel that a

Serial No. 09/681,804
Art Unit: 2131

telephone interview with Applicant's attorney would further advance the case, please
contact Applicant's attorney at 404.954.5061.

Respectfully submitted,

MERCHANT & GOULD, LLC



Dated: **Februray 14, 2006**

Charles Vorndran, Ph.D.
Reg. No. 45,315

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5100

23552